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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,785	04/02/2004	Nicola Leone	T8-467921US	9935
Arne I. Fors c/o Gowling Lafleur Henderson LLP Suite 4900 Commerce Court West Toronto, ON M5L 1J3 CANADA			EXAMINER GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER
			3679	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/815,785

Applicant(s)

LEONE ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-12,14,15 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-8,12,14,15 and 17-25 is/are rejected.
- 7) ☒ Claim(s) 15,17-19 and 22-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

Applicants are reminded that the amendment to the specification and the remarks must begin on a separate sheet.

Election of Species

Applicant's election of species I, Figures 1-4, 8, and 9, in the reply filed on February 10, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 9-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 10, 2006.

Drawings

The drawings were received on March 7, 2006. These drawings are acceptable; however, there is still an objection pending.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the insert is plastic" (claim 21) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Note that all the figures show a metal insert as indicated by the cross hatching for metal in Figures 2 and 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct

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any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 4, 6-8, 12, 14, 15, 17-19, and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the recitation that the shape be elliptical-shaped along with the equi-distant features from the center is misdescriptive or inaccurate. Since an elliptical-shaped insert is not symmetrical, how can the brackets and the abutment surfaces be equi-distant from the center as required by claim 1, lines 9-10.

Regarding claims 4 and 15, the term "intermediate" in line 3 is a relative term which renders the claim indefinite. The term "intermediate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and

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one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In other words, to what is the "intermediate" rail intermediate to?

Regarding claim 14, the metes and bounds of the claim is unclear. In particular, how does a picket fence having the ornamental fence insert of claim 4 define the picket fence? Does merely reciting the insert of claim 4, constitute a picket fence?

Regarding claim 15, the recitation "the bottom rail" in line 11 lacks proper antecedent basis. Note that antecedent basis is provided for "an intermediate rail" in line 3.

Regarding claims 6-8, and 12, the claims depend from claim 4 and therefore are indefinite.

Regarding claims 17, 18, and 22-25, the claims depend from claim 15 and therefore are indefinite.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 6-8, 12, 14, 20, and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D522,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because the design patent anticipates the insert as claimed in the instant application.

Claims 15, 17-19, and 22-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claim of U.S. Patent No. D522,664, in view of Zhu, 6,648,304.

With regards to claim 15, U.S. patent does not disclose rails, pickets, and rectangular spaces with the rails and the pickets. Zhu teaches these features and one of ordinary skilled in the art would know that the insert in D522,664, is for a fence as the

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title suggest. Therefore, it would have been obvious to include the rails, the pickets, and the rectangular spaces with the rails and the pickets to the ornamental design of the Leone et al. patent to arrive at an ornamental fence using the fence insert as shown in the patent D522,664. With respect to claims 17-19, these claims are inherent features of the ornament insert described on the patent D522,664. With respect to claims 22-25, the use of metal or plastic is an obvious matter of design choice to construct the insert.

Claim Rejections - 35 USC § 102

Claims 1, 3, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Gibbs, 6,254,064.

Regarding claim 1, Gibbs discloses, in Figure 2, an ornamental insert comprising a body **20** (see marked-up attachment) having a perimeter and a center. The body **20** has brackets **22,24** projecting from the perimeter from diametrically opposite sides of the body **20**. Each of the brackets **22,24** has a pair of opposed sidewalls. The body **20** has abutment surfaces formed on the perimeter on diametrically opposite sides of the body **20** between the brackets **22,24** and equi-spaced from the brackets **22,24**. The brackets **22,24** and the abutment surface are equi-distant from the center.

Regarding claim 3, the ornamental insert body **20** is circular.

Regarding claim 20, the insert is metal (see cross-hatching).

Claim Rejections - 35 USC § 103

Claims 1, 4, 8, 12, 14, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krauser, 7,774.

Regarding claim 1, Krauser discloses, in Figure 1, an ornamental insert comprising a body **A1** (see marked-up attachment) having a perimeter **A2** and a center **B1**. The body **A1** has brackets **n** projecting from the perimeter **A2** from diametrically opposite sides **A4** of the body **A1**. Each of the brackets **n** has a pair of opposed sidewalls **A5**. The body **A1** has abutment surfaces **A6** formed on the perimeter **A2** on diametrically opposite sides **A7** of the body **A1** between the brackets **n** and equi-spaced from the brackets **n**. However, Krauser fails to disclose the brackets **n** and the abutment surface **A6** are equi-distant from the center **B1**. Applicant is reminded that a change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been an obvious matter of design choice to make the bracket and the abutment surface equi-distant from the center since such a modification would have involved a mere change in the size of a component. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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Regarding claim 4, Krauser discloses, in Figure 1, an ornamental insert comprising a body **A1** having a perimeter **A2** and a center **B1**. The body **A1** has brackets **n** projecting from the perimeter **A2** from diametrically opposite sides **A4** of the body **A1**. Each of the brackets **n** has a pair of opposed sidewalls **A5** defining a u-shape. The body **A1** has abutment surfaces **A6** formed on the perimeter **A2** on diametrically opposite sides **A7** of the body **A1** between the brackets **n** and equi-spaced from the brackets **n**. However, Krauser discloses the abutment surfaces **A6** being rightward and leftward and the brackets **n** projecting vertically from the perimeter. The brackets **n** and the abutment surfaces **A6** are equidistant from the center **B1**.

Applicants should note that the limitations “upwardly” and “downwardly” are relative terms that orienting the insert 90 degrees from vertical, during transportation, will place the abutment surface upward and downward and the bracket will project horizontally from the perimeter. Further, applicants are reminded that the downwardly facing abutment surface can be adapted to seat on an intermediate rail top surface and the upwardly facing abutment surface can be adapted to abut with the top rail bottom surface.

Regarding claim 8, the body is substantially circular-shaped (note that the body has an 8-shape comprising two circles, thus substantially circular-shaped).

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Regarding claim 12, Krauser, as discussed, fails to disclose the body being substantially elliptical-shaped. Applicant is reminded that changing the body from an 8-shape to an elliptical shape would have been an obvious matter of design choice to change the appearance of the insert to appeal those that dislike symmetry. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the shape of the main insert to an elliptical shape for an unsymmetrical appearance.

Regarding claim 14, Krauser disclose a picket fence. The picket fence has an ornamental fence insert comprising the features of claim 4 as rejected.

Regarding claim 20, the insert is metal.

Regarding claim 21, Krauser, as discussed, fails to disclose the insert being plastic. Applicants are reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the insert of plastic. *In re Leshin*, 125 USPQ 416.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbs, 6,254,064.

Regarding claim 21, Gibbs, as discussed; fails to disclose the insert being plastic. Applicants are reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the insert of plastic. *In re Leshin*, 125 USPQ 416.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krauser, 7,774, in view of Zhu, 6,648,304.

Regarding claim 6, Krauser, as discussed above, fails to disclose the opposed sidewalls being joined by a web. Zhu teaches, in Figure 3, a sidewalls 50 joined by web to mount a bracket to body 12 using screws instead of being integral with the body. Therefore, as taught by Zhu, it would have been obvious to one of ordinary skill in the art at the time the invention was made to join the sidewalls using a web to connect the brackets of Krauser to the body instead of making the brackets integral with the body.

Regarding claim 7, applicants are reminded that given the structure of the sidewalls of Krauser, the sidewalls can be adapted to overlap a surface of one picket, in a direction of a horizontally extending direction of the rails by a distance less than one

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half of the dimensions of the picket in the direction. Given the modification, the sidewalls of adjacent fence inserts would not impinge.

Allowable Subject Matter

Claims 15, 17-19, and 22-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 15, the prior art of record does not disclose or suggest a picket fence comprising an ornamental body comprising both flat abutment surfaces formed on a perimeter of the circular body, on diametrically opposite sides of the body between brackets, and the brackets projecting from the perimeter from diametrically opposite sides of the body and defining a U-shape, and the flat abutment surfaces being in respective contact with a top rail and a bottom rail. The closest prior art, Krauser, 7,774, teaches no flat abutment surfaces in contact with a bottom rail and a top rail; and,

regarding claims 17-19 and 22-25, these claims depend from claim 15.

Response to Arguments

Applicants' arguments filed February 10, 2006 have been fully considered but they are not persuasive.

Applicants argue that claim 1 and claim 2 has been combined to recite that "the brackets and abutment surfaces are recited as being equi-distant from the insert center to fit into a square opening". In response, applicants should note that the method of how the insert is used, in particular, how it is to fit into a square opening is irrelevant, when patentability is based on the structural differences of the insert between the prior art and the claimed invention, and not how the insert is to be employed.

Applicants remark that it is difficult to relate Figure 5 to Figure 11. It should be noted that Figure 5 is a side view of the insert (unreferenced; the piling) being between two tubes. The rod H as seen in Figure 5 is interposed so that the rod extends between posts as seen in Figure 2 by the letter m. Note that the rod has been designated with different reference characters but the scope is to mount the tube unreferenced in Figure 5 to the rods H.

With respect to claim 4, applicants argue that Krauser fails to disclose how the abutment surfaces are adapted to the rails. In response, it should be noted that how the

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insert is to be employed does not define patentability. Further, Krauser, meets all the structural limitations of the insert since the insert is what is being claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. In particular, the new limitations "and abutment surfaces ... the center" in claim 1, lines 7-10, "and in which said downwardly ... the center" in claim 4, lines 12-16, and "in abutment with the top rail bottom surface and" in claim 15, line 10, necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-282-7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

E.G.

November 27, 2006

Attachments: one marked-up page of Krauser, 7,774

Krauser, 7,774

Daniel P. Stodola

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

